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| 10/820,988 | 04/08/2004 | Francisco Faoro | ZIM0353 | 9041 |

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04/03/2007

EXAMINER

SCHILLINGER, ANN M

ART UNIT

PAPER NUMBER

3738

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 04/03/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/820,988

Applicant(s)

FAORO, FRANCISCO

Examiner

Ann Schillinger

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☒ Claim(s) 15-19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date 6/10/04.

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "95" has been used to designate both actuation lever and base part. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Allowable Subject Matter

Claims 15-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Burkinshaw et al. (U.S. Pat. No. 6,013,081). Burkinshaw et al. discloses the following of claim 1: an apparatus for the fixing of the position of bone cuts for the insertion of knee implants, comprising at least one cutting jig (16, 18) which is adapted to be coupled to a base element (12) fixed to the bone in the region of a condyle and is adapted to be fixed to the base element, wherein the cutting jig defines, in the fixed state and in each case by means of a slot (96, 160) for a cutting tool, a first cutting plane with respect to the base element and a second cutting plane with respect to the first cutting plane and wherein at the cutting jig the orientation of the second cutting plane is rotatably adjustable relative to the first cutting plane (all of col. 6, and col. 7, lines 1-7) while the cutting jig is remains coupled to the base element (col. 5, lines 61 through col. 6, line 40, and col. 6, lines 50-56) and while taking the respective knee anatomy into account (via 22).

Burkinshaw et al. continues with the apparatus described in claims 2-10 and 14 with a cutting jig (16, 18) defining slots with two cutting planes, where the two cutting slots are adjustable relative to each other (all of column 6) and the base plate (12), and are perpendicular, where an adjustable probe device (22) can take knee anatomy into account and is coupled to the slots (16, 18), where a plurality of cuts to accommodate a variety of implant sizes can be made by adjustment, where the cutting jig (16) may be moved parallel to the cutting plane of part 18 along the side groove of piece 12. The slot guides (16, 18) may also be used simultaneously for cutting and an additional abutment, also the edges of each slot form abutment elements for the cutting tool to restrict the cut, alternatively the holes of the apparatus (Figure 11) may form guides for abutment instruments (being pins) which intersect all planes of cutting where all

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abutments are coupled to the slot element or are the slot element themselves. The cutting jig, further encompasses a clamping device (20) with an actuating member (121) by which the clamping element (134) is fixed to the base element (12) and simultaneously, the orientation of a cutting plane can be fixed relative to another cutting plane.

It should be noted that the claim language “adapted to/for” is functional language. In order to be given patentable weight, a functional recitation must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1929 C.D. 172; 388 O.G. 279.

Claims 1, 4, 5, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Gustilo et al. (U.S. Pat. No. 5,925,049). Gustilo et al. discloses a cutting jig (300) with portions 302 and 350 and base portion 320 (Figure 24) where the cutting planes are slots and are adjustable relative to each other and the base element via the holes (306, 304; col. 2, lines 15-26) where the jig is guided by the grooves of the base element at each corner (Figure 24). The cutting jig remains coupled to the base element and while taking the respective knee anatomy into account (col. 9, lines 40-58 and col. 10, lines 53-67). Any of the slots and holes of the device are fully capable of use as a guide for an abutment. Furthermore, the components may be spaced apart, as shown in the embodiment of figure 36, where the upper side of the base element will form an intermediate space forming a slot and is fully capable of being a cutting plane.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being anticipated by Burkinshaw et al. in view of Duffner (U.S. Pat. No. 67,96,986). Burkinshaw et al. and Gustilo et al. do not disclose the turntable feature of the cutting jig for ease of use. However, Duffner discloses an apparatus with a cutting jig (200) defining slots (270) with two cutting planes, where the two cutting slots are adjustable relative to each other via the radially moving arms (140, 120) and relative to the base (110, 130) via sliding along the arms, where the cutting jig (20) may be moved parallel to the cutting plane by sliding along the arms (140,120). The slot guides (16, 18) may also be used simultaneously for cutting and an additional abutment, also the edges of each slot form abutment elements for the cutting tool to restrict the cut, alternatively the holes of the apparatus (Figure 11) may form guides for abutment instruments (being pins) or the arms (120, 140) may be guides for an abutment instrument, where and abutment instrument using at least one of these guides is fully capable of intersecting all planes of cutting where all abutments are coupled to the slot element or are the slot element themselves. The cutting jig, further encompasses a clamping device (170, 175) with an actuating member (130) by which the clamping element (170, 175) is fixed to the base element (110, 130) and simultaneously, the orientation of a cutting plane can be fixed relative to another cutting plane. The knob (170) is a turntable arrangement that is rotatably supported on the cutting jig (110), where the axis of the knob is perpendicular to the cutting planes and the cutting guides (200) are rotatably connected to the turntable and are capable of forming a guide for an abutment. Rotating the turntable structure will correspond to a change in the guide structure, which is also rotatable (col. 3, lines

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31-45). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize this turntable feature to make it easier to use the cutting jig.

Response to Arguments

Applicant's arguments filed 2/8/2007 have been fully considered but they are not persuasive. Applicant contends that with the limitations added to claim 1, Burkinshaw et al. no longer reads on claims 1-10 and 14. However, Burkinshaw et al. discloses these additional limitations in col. 7, lines 1-7, col. 5, lines 61 through col. 6, line 40, and col. 6, lines 50-56. Therefore, claim 1 and its dependent claims stand rejected for these reasons and the citations given above.

Applicant also contends that the limitations added to claim 1 overcome a rejection by the Gustilo et al. reference. However, the Gustilo et al. discloses these limitations in col. 2, lines 15-26, col. 9, lines 40-58, and col. 10, lines 53-67. Therefore, claim 1 and its dependent claims 4, 5, and 11 stand rejected under Gustilo et al. for these reasons and the citations given above.

Regarding the arguments of claims 12 and 13 the Applicant contends that the added limitations to claims 1 and 12 overcome the 35 USC 103(a) rejection of Burkinshaw et al. in view of Duffner. Burkinshaw et al. discloses the additional limitations of claim 1, as described above, and Duffner discloses in col. 3, lines 31-45 the rotational adjustment movement that impacts the arms, which as described above, house the holes of the apparatus that may form guides. Therefore claims 12 and 13 stand rejected for these reasons and the citations given above.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Schillinger whose telephone number is (571) 272-6652. The examiner can normally be reached on Mon. thru Fri. 9 a.m. to 4 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ann Schillinger
March 5, 2007


ALVIN J. STEWART
PRIMARY EXAMINER